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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

08350.1488

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on _____

Signature _____

Typed or printed name _____

Application Number

10/027,032

Filed

December 20, 2001

First Named Inventor

Douglas C. Meyer

Art Unit

3627

Examiner

Kramer, James

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☒ attorney or agent of record.

Registration number 28,220

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

David W. Hill

Typed or printed name

571-203-2735

Telephone number

March 1, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 form is submitted.

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EXAMINING GROUP 3627

PATENT

Customer No. 22,852

Attorney Docket No. 08350.1488

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Douglas C. Meyer)	Group Art Unit: 3627
)	
Application No.: 10/027,032)	Examiner: Kramer, James
)	
Filed: December 20, 2001)	Confirmation No.: 2259
)	
For: METHOD OF MANAGING)	Mail Stop AF
INVENTORY)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In reply to the Final Office Action mailed October 12, 2005, and pursuant to the July 12, 2005, OG Notice regarding the Pre-Appeal Brief Conference Program, Applicant respectfully requests panel review of the rejections under 35 U.S.C. § 103(a) discussed in the remarks below. No amendments are being filed with this Request. This Request is concurrently being filed with a Notice of Appeal and a petition for a two-month extension of time.

REMARKS

I. Status of Claims

Claims 1 and 3-52 remain pending in this application with claims 1, 12, 18, 27, and 52 being the independent claims. Claims 12-31 and 38 had been previously withdrawn from consideration. Claims 1, 3-10, 32, 33, 36, 37, 39, 44-49, and 52 stand rejected as being unpatentable over Brockman (U.S. Patent No 5,884, 300) in view of Mahon et al. ("Mahon") (U.S. Patent No 6,785,361). Claims 11, 42, 43, 50, and 51 stand rejected as being unpatentable over Brockman in view of *Official Notice*. Claims 34, 35, 40, and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brockman in view of Hoblit et al. ("Hoblit") (U.S. Patent Application Publication No. US2002/0072977).

II. Rejection of Claims Under Section 103(a) Should Be Withdrawn

Applicant respectfully submits that the Examiner failed to establish a *prima facie* case of obviousness in rejecting claims 1, 3-10, 32, 33, 36, 37, 39, 44-49, and 52 as being unpatentable over Brockman in view of Mahon for at least the reason that no combination of Brockman and Mahon teaches or suggests every claim element. The rejected claims include terms that are associated with a method of improving records of inventory at a facility. For example, claim 1 recites a combination of steps including, *inter alia*, "establishing a plan . . . , the plan including a change to current inventory practices including one or more of adding an inventory process, modifying an inventory process, or deleting an inventory process; and implementing the change to correct the at least one discrepancy." Brockman does not teach at least these claim steps.

In an attempt to overcome this deficiency of Brockman, the Examiner has stated that one skilled in the art would have been motivated to modify Brockman with process changes as taught by Mahon. See Final Office Action at page 4 (citing Mahon at column 3, line 61-column 4, line 20). However, the Examiner's claim is unsupported by the record. The claim elements mentioned above are clearly related to a method of improving records of inventory at a facility. Indeed, these elements all include language (e.g., adding an inventory process, modifying an inventory process, deleting an inventory process) specific to inventory records. Mahon is not even related to inventory management. Instead, Mahon discloses a system and method for ensuring the quality of a performance measurement in a telecommunications network. See Request for Reconsideration at pages 3-4. Thus, it is clear that Mahon does not teach the above-mentioned claim elements.

In the Advisory Action dated February 8, 2006, the Examiner apparently agreed with Applicant's assertion that Mahon is not related to inventory management. However, the Examiner asserted that Mahon was relied upon only for "general teachings associated with management and methods of doing business." See Continuation Sheet of Advisory Action. Applicant respectfully submits that the Examiner may not properly make broad generalizations from Mahon and apply them to the claim elements at issue. By applying Mahon in this manner, the Examiner has disregarded a number of expressly recited claim terms that are related to a method of improving records of inventory at a facility. Furthermore, the Examiner has provided no evidence of a suggestion in Mahon to modify the disclosure in Brockman to further perform at least the above-mentioned claim steps.

It is clear that determinations of obviousness must be supported by evidence on the record. See Request for Consideration at page 4. Furthermore, the prior art must suggest the desirability of the combination. Id. at 5. In this case, the Examiner has not shown by "clear and particular evidence" that a skilled artisan considering Mahon, and not having the benefit of Applicant's disclosure, would have modified Brockman in a manner resulting in the method defined by claim 1. Applicant submits that the Examiner is impermissibly using teachings of the present application in hindsight to suggest that claim limitations of the present application would be obvious to one having ordinary skill in the art in view of Mahon. Such use of impermissible hindsight in concluding obviousness is prohibited. See M.P.E.P. § 2142. Therefore, Applicant submits that there is no motivation for one skilled in the art of inventory management to look to the teachings of process changes allegedly suggested or disclosed in Mahon to modify Brockman so as to render claim 1 obvious.

Mahon is not related to a method for improving inventory management. Thus, it reasonably follows that Mahon does not disclose or suggest at least the above-mentioned recitations of claim 1 related to a method of improving records of inventory at a facility. It also reasonably follows that Mahon cannot, and indeed does not, suggest a modification to Brockman to perform the above-mentioned claim recitations. Indeed, nothing even approaching inventory management related language (e.g., adding an inventory process, modifying an inventory process, deleting an inventory process, etc.) is present in Mahon. Accordingly, the rejection of claim 1 should be withdrawn.

Independent claims 37 and 52, although different in scope, each contain elements corresponding to the element of claim 1 that distinguishes claim 1 from

Brockman and Mahon. For at least these reasons, *prima facie* obviousness has not been established with respect to claims 1, 37, and 52. The rejection of claims 1, 37, and 52 under 35 U.S.C. § 103(a) should therefore be withdrawn. The § 103(a) rejection of dependent claims 3-10, 32, 33, 36, 39, and 44-49 should be withdrawn as well, for at least the same reasons as those presented above in connection with base claims 1 and 37.

The Section 103(a) rejection of claims 11, 42, 43, 50, and 51 as being unpatentable over Brockman in view of *Official Notice*, and of claims 34, 35, 40, and 41 as being unpatentable over Brockman in view of Hoblit should also be withdrawn for the reasons discussed on pages 6 and 7 of the Request for Reconsideration dated January 12, 2006.

III CONCLUSION

Because the Examiner's 35 U.S.C. § 103(a) rejections over Brockman and Mahon are severely flawed, Applicant respectfully requests withdrawal of those rejections.

Please grant any extensions of time required to enter this request and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 1, 2006

By: David W. Hill
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